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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,650	09/15/2003	Yoichi Kanai	242873US2	9352
22850	7590	12/15/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MILLA, MARK R	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 12/15/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/661,650

Applicant(s)

KANAI ET AL.

Examiner

Mark R. Milia

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12-15, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-15, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/08 has been entered. Currently, claims 1-6, 12-15, and 21-22 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 12, 21, and 22 have been considered but are moot in view of the current amendment to the claims and therefore a new ground(s) of rejection will be made.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 12-15, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pensak (US 6,289,450) in view of U.S. Patent Application Publication No. 2003/0191938 to Woods et al.

Regarding claim 1, Pensak discloses a document printing program encoded on a computer readable medium, comprising the codes of: obtaining a print requirement associated with a document file (see column 6 lines 18-60) and compulsory executing the print requirement when the document file is printed out (see column 6 lines 50-55 and column 8 lines 47-56), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56, an authoring user creates options associated with a document that specify software functions to be enforced by an application interface, the document is then segmented and encrypted, a segment may also be the entire document, a viewing user may request the document, or segments thereof, and after the application interface decrypts a segment, the application interface enforces the option, such as printing with a watermark).

Pensak does not disclose expressly obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file.

Woods discloses obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file (see paragraphs 26, 57-58, and 65, reference states that the password is the basis of the key for encryption and decryption of a file).

Regarding claim 12, Pensak discloses a document protecting program encoded on a computer readable medium, comprising the codes, of: obtaining an encryption key used to encrypt a document file (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), associating print requirement with the document file (see column 6 lines 18-60 and column 8 lines 47-56), and encrypting the document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56, an authoring user creates options associated with a document that specify software functions to be enforced by an application interface, the document is then segmented and encrypted, a segment may also be the entire document, a viewing user may request the document, or segments thereof, and after the application interface decrypts a segment, the application interface enforces the option, such as printing with a watermark).

Pensak does not disclose expressly obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file.

Woods discloses obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file (see paragraphs 26, 57-58, and 65, reference states that the password is the basis of the key for encryption and decryption of a file).

Regarding claim 21, Pensak discloses a document protecting system comprising: a distributor terminal implementing a document protecting program encoded on a computer readable medium comprising the codes of: a part obtaining an encryption key to encrypt a document file (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), a part associating a print request to the document file (see column 6 lines 18-60 and column 8 lines 47-56), and a part encrypting the document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), and a user terminal (see Figs. 1 and 2) implementing a document printing program comprising the codes of: a part obtaining a decryption key of document file being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), a part decrypting the document file based on the obtained decryption key (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), a part obtaining a print requirement associated with the document file (see column 6 lines 18-60 and column 8 lines 47-56), and a part executing a printing process so as to satisfy the print requirement (see column 8 lines 35-56), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56, an authoring user creates options associated with a document that specify software functions to be enforced by an application interface, the document is then segmented and encrypted, a segment may also be the entire document, a viewing user may request the document, or segments thereof, and after the application

interface decrypts a segment, the application interface enforces the option, such as printing with a watermark).

Pensak does not disclose expressly obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file.

Woods discloses obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file (see paragraphs 26, 57-58, and 65, reference states that the password is the basis of the key for encryption and decryption of a file).

Regarding claim 22, Pensak discloses a document protecting system comprising: a server implementing a document protecting program encoded on a computer readable medium comprising the codes of: obtaining an encryption key used to encrypt a document file (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), associating a print requirement with the document file (see column 6 lines 18-60 and column 8 lines 47-56), and encrypting the document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), and a user terminal (see Figs. 1 and 2) comprising the codes of: obtaining a decryption key of a document being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), obtaining a print requirement associated with the document (see column 6 lines 18-60 and column 8 lines 47-56), and executing a printing process so as to satisfy the obtained print requirement (see column 8 lines 35-56), wherein the print requirement sets a print mode

including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56, an authoring user creates options associated with a document that specify software functions to be enforced by an application interface, the document is then segmented and encrypted, a segment may also be the entire document, a viewing user may request the document, or segments thereof, and after the application interface decrypts a segment, the application interface enforces the option, such as printing with a watermark).

Pensak does not disclose expressly obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file.

Woods discloses obtaining a password and the password is utilized to generate a key for encryption and decryption of the document file (see paragraphs 26, 57-58, and 65, reference states that the password is the basis of the key for encryption and decryption of a file).

Pensak & Woods are combinable because they are from the same field of endeavor, security of document files utilizing encryption.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine a password being the basis for generating a key used for encryption and decryption, as described by Woods, with the system of Pensak.

The suggestion/motivation for doing so would have been to increase the security of the document by using a password to generate a key for encryption and decryption.

Therefore, it would have been obvious to combine Woods with Pensak to obtain the invention as specified in claims 1, 12, 21, and 22.

Regarding claim 2, Pensak further discloses wherein the print requirement is compulsory enforced by executing a printing process with the print requirement when the document file being encoded is decrypted (see column 8 lines 35-56).

Regarding claim 3, Pensak further discloses obtaining a decryption key for the document file being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), decrypting the document file based on the obtained decryption key (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), obtaining the print requirement associated with the document file (see column 6 lines 50-55 and column 8 lines 47-56), and executing a printing process so as to satisfy the obtained print request (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 4, Pensak further discloses wherein the print requirement is obtained from the decrypted document file (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 5, Woods further discloses wherein the password corresponding to an encryption key used to encrypt the document file is obtained from a user, and a decryption key is generated by the password (see paragraphs 7, 26, and 65).

Regarding claims 6 and 15, Pensak further discloses wherein a parameter, which is internally maintained or generated, is used to generate the decryption key (see column 2 lines 44-57 and column 3 lines 11-25).

Regarding claim 13, Pensak further discloses wherein the document file and the print requirement are associated with each other by providing the print requirement to the document file and then encrypting the document file with the print requirement (see column 6 lines 31-60).

Regarding claim 14, Pensak further discloses wherein an encryption key is generated based on a password input by a user (see column 3 lines 62-65).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571)272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
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